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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,138	10/15/2003	Brian J. Brown	03-167US (202.0080001)	6236
54953 7590 12/16/2008 BROOKS, CAMERON & HUEBSCH, PLLC 1221 NICOLLET AVENUE SUITE 500 MINNEAPOLIS, MN 55403				
EXAMINER				
TYSON, MELANIE RUANO				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,138

Applicant(s)

BROWN ET AL.

Examiner

Melanie Tyson

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the applicant's amendment received on 16 September 2008. Corrections made have been accepted. Claims 10, 11, 20, and 21 remain cancelled. Claims 23 and 24 remain withdrawn from consideration.

Response to Arguments

Applicant's arguments with respect to claims 1-9, 12-19, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites the RF marker is "embedded" in the structural material of the stent, which contradicts claim 1, from which claim 9 directly depends, which recites the marker forms concentric loops on an "outside surface" of the cells. Claim 19 recites the RF marker is "embedded" in the structure, which contradicts claim 13, from which claim 19 directly depends, which recites the markers are located on an "outside surface" of the peripheral surface of the structure. Appropriate clarification through corrections is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3773

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4, 5-9, 13, 14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Solovay (U.S. Patent No. 6,482,227 B1) in view of Case et al. (U.S. Publication No. 2004/0167619 - cited on 892 dated 3/12/07)**. Solovay discloses a stent (see entire document) comprising a structure substantially invisible under MRI visualization (Nitinol material possesses poor MRI visualization properties, thus is considered to be substantially invisible) having first and second cells at a first end of the stent facing opposite directions (thus having orthogonal axes generally perpendicular to each other), and RF markers (15) that forms generally concentric loops on an outside surface (in that the marker is only coiled around the top, bottom, and side outside surfaces as opposed to embedded at a depth beneath these surfaces) of each of the first and second cells (for example, see Fig. 1) capable of performing the functions as claimed.

Solovay fails to disclose the markers delineate a circumference of the cells. Case discloses a device comprising markers (see entire document). Solovay teaches the

markers may delineate a circumference of a cell or aperture (for example, see Figure 15) in order to provide precise identification of the cell or aperture (for example, see paragraph 52). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form Solovay's markers such that they delineate the circumference of the cells as taught by Case. Doing so would provide the advantage described above, thus enabling precise positioning of the device within a body lumen.

With further respect to claim 5-8, Solovay fails to disclose an RF marker on a fourth cell (Solovay discloses an RF marker on three cells). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the stent with a fourth marker as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

With further respect to claims 9 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed the RF marker in the stent structure since the applicant has not disclosed that embedding the marker provides an advantage, is used for a particular purpose, or solves a stated problem and it appears the invention would work equally well coiled around the outside surface of the stent.

Claims 2, 3, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Solovay in view of Case et al. as applied to claims 1 and 13 above, and further view of Doran et al. (2002/0055770 A1)**.

Solovay discloses the claimed invention except for ceramic struts and polymer connectors. Doran discloses a stent (see entire document) comprising cells. Doran teaches the cells are interconnected by connectors in order to increase flexibility of the stent (for example, see paragraph 83). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct Solovay's stent with connectors as taught by Doran. Doing so would provide a more flexible stent body. Furthermore, Doran teaches the stent and connectors may be made from materials such as ceramics, polymers, and combinations thereof (for example, see paragraph 187). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the struts of ceramic material and the connectors of a polymer material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Solovay in view of Case et al. as applied to claims 1 and 13 above, and further view of Jackson et al. (U.S. Publication No. 2003/0004563)**. Solovay discloses the claimed invention except for a magnetic susceptibility marker. Jackson

discloses a tubular structure (see entire document). Jackson teaches connecting magnetic susceptibility markers (such as paramagnetic materials; paragraph 16) that are visible under MRI to the tubular structure. It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct Solovay's stent with a magnetic susceptibility marker as taught by Jackson. Doing so would further enable a user to clearly recognize the position of the stent under MRI (for example, see paragraph 16), thus facilitating proper implantation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
November 28, 2008

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773